

REMARKS

I. STATUS OF THE CLAIMS

Claims 1 and 5-63 are pending in this Application. Claims 9-12, 15-17, and 33-63 are withdrawn. Claim 4 was cancelled and the limitations recited therein were incorporated into independent claim 1.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner. Applicants submit that the proposed amendment of claim 1 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final Office Action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Applicants acknowledge and appreciate that the Examiner has withdrawn the Section 112, first paragraph, rejection of claims 1, 4-8, 13, 14 and 18-32. Applicants further acknowledge and appreciate that the Examiner has withdrawn the Section

103(a) rejection of claims 1, 4-8, and 18-30 over U.S. Patent No. 4,006,272 to Sakaguchi in view of U.S. Patent No. 6,139,958 to Raghupathi et al. ("*Raghupathi*").

II. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 4-8, 13, 14 and 18-32 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,340,519 to Kotera et al. ("*Kotera*") in view of *Raghupathi* for reasons discussed at pages 2-5 of the Office Action. Applicants respectfully traverse this rejection for at least the reasons that follow.

To establish a prima facie case of obviousness over a combination of references, the Examiner "bears the initial burden of factually supporting any prima facie conclusion of obviousness." *Cf. In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Specifically, the Examiner must prove such a desire to combine references with "substantial evidence" that is a result of a "thorough and searching" factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002). The Federal Circuit has on numerous occasions stated that to establish a prima facie case of obviousness an Examiner must show that the references, taken in combination, (1) teach all the present claim limitations; (2) would have suggested to or provided motivation for one of ordinary skill in the art to make the claimed invention; and (3) would have provided one of ordinary skill with a reasonable expectation of success in so making. *See In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (*citing In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988)). "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant's disclosure." *In re Vaeck* at 1442 (emphasis added).

In the present case, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness because the Examiner has not shown that *Kotera* and *Raghupathi*, in combination, meet the aforementioned requirements. See M.P.E.P. §§2143.01, 2143.02, & 2143.03.

1. All limitations not taught or suggested

First, Applicants respectfully submit that the rejection under § 103 is fatally flawed because neither *Kotera* nor *Raghupathi*, nor combination of the two, teach all of the limitations of claims 1, 5-8, 13-14 and 18-32. The disclosure in *Kotera* fails to teach, *inter alia*, “[a] fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible powdered coating composition on at least a portion of a surface of the fabric, . . . wherein the at least one fiber strand comprises at least one glass fiber,” as recited in claim 1. Conspicuously absent from the disclosure in *Kotera* is any mention of fabric comprising at least one glass fiber strand. Indeed, the Examiner acknowledges this fact by stating that “*Kotera* does not specifically teach glass fibers.” Final Office Action at page 4. Although the Examiner broadly states, however, that “*Kotera* teaches that his composition can be used to surface treat plastic and glass products, wherein said treatable products . . . are suitable as materials for windows, lens, or the like, (more specifically, panels),” this does nothing to rectify the absence of any mention of glass fibers in the reference.

Applicants assert that nothing in *Raghupathi* corrects the deficiencies of *Kotera*. *Raghupathi* teaches chemically treated glass fibers that assist in reinforcing thermosetting polymer matrices. Moreover, *Raghupathi* expressly teaches that the

coated glass fibers are used to reinforce products by dispersing the individual, chopped glass fiber strands "somewhat uniformly over the polymeric matrix." *Raghupathi*, col. 9, lines 17-19. The dispersed glass fibers then "settle and become wet-out in the polymeric matrix." *Id.* This process is repeated in *Raghupathi's* examples. See *id.*, col. 11, lines 4-7. Such a teaching in *Raghupathi* clearly indicates that a woven *fabric* comprising at least one glass fiber strand is not utilized in reinforcing the polymer matrices, since the individual, chopped fibers are simply distributed over the matrix material as opposed to woven into a fabric prior to their incorporation. Since the present invention requires, *inter alia*, "[a] fabric comprising at least one strand comprising a plurality of fibers, . . . wherein the at least one fiber strand comprises at least one glass fiber," *Raghupathi* fails to anticipate claim 1 and claims 4-8, 13, 14 and 18-32, which depend from claim 1.

Accordingly, both *Kotera* and *Raghupathi* fail to teach all the present claim elements. Accordingly, Applicants submit that this rejection is improper under M.P.E.P. § 2143.03 and respectfully request that it be withdrawn.

2. There is no suggestion or motivation for one in the art to make the claimed invention

Applicants respectfully submit that the Examiner cannot demonstrate a suggestion or motivation to modify the teachings of *Kotera* and *Raghupathi* to make the claimed invention because there is no motivation to combine the teachings of the two references. In fact, both references expressly teach away from the combination. It is well-settled that claims are not obvious if the cited reference or other relevant art

teaches away from the claimed invention. M.P.E.P. § 2145(X)(D)(1). Indeed, the Federal Circuit has held a prior art reference must be considered in its entirety, and one may not “disregard[] disclosures in the references that diverge from and teach away from the invention at hand.” *W.L. Gore & Assocs., Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983); see also, *Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). Thus, the Examiner must consider the entire disclosure of *Kotera* and *Raghupathi*, including those portions that are inconsistent with his asserted position. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (“a rejection cannot be predicated on the mere identification in [a prior art reference] of individual components of claimed limitations”).

Central to the invention disclosed in *Kotera* is a polyester resin that is utilized “for various utilities such as coating compositions, laminated products, aqueous printing ink, aqueous binder for coating, and surface treating agent for giving drip-proof.” *Kotera*, col. 2, lines 15-20. Indeed, *Kotera* expressly teaches that the resin gives “a coating film having excellent water resistance and excellent weatherability.” See, e.g., *id.*, col. 1, lines 7-8; col. 2, lines 11-12; col. 2, lines 14-15; col 7, lines 47-48. Such language clearly implies that the resin acts as an external coating for a finished object. Indeed, the Examiner acknowledges this fact, stating “*Kotera* teaches that his composition can be used to *surface treat* plastic and glass products. . . .” Final Office Action at page 4 (emphasis added).

Moreover, the potential uses of the polyester resin disclosed in *Kotera* refer to products in which the coating would be on an external surface. See *id.*, col. 2, lines 15-

20, and col. 7, lines 41-47 (describing potential uses of the polyester resin aqueous dispersion, “such as adhesives, inks, particularly aqueous printing ink, coating composition, aqueous binder for coating, treating agent for textile or paper products, particularly surface treating agent for giving drip-proof, or the like. . . .”).

All the Examples found in *Kotera* further support this fact. The Examples refer to coating the polyester resin onto the external surfaces of film, steel panels, and non-glass fabric. In some instances, two layers of the claimed resin coatings were applied; however, there is no evidence that any of the coatings were subsequently coated with additional compositions, such as matrix materials, chemically different from the resins claimed in *Kotera*.

Furthermore, *Kotera* does not suggest that there is any problem that needs correction or any advantage that could be obtained by modifying the disclosed aqueous polyester resin dispersion by incorporated the coated articles into a matrix. In the absence of such a teaching, one skilled in the art would not have been motivated to modify the teachings of *Kotera* by incorporating aspects of *Raghupathi* in an attempt to arrive at the presently claimed invention.

An examination of the entire disclosure in *Raghupathi* leads one of skill in the art away from a combination with *Kotera*. As discussed above, *Raghupathi* discloses coated glass fibers that are used to reinforce products by dispersing the individual, chopped glass fiber strands “somewhat uniformly over the polymeric matrix.” *Raghupathi*, col. 9, lines 17-19. The dispersed glass fibers then “settle and become wet-out in the polymeric matrix,” *id.*, wherein “[w]et-out means that the matrix polymer

encapsulates the glass fibers and very little, if any, bare glass is visible throughout the cured, fiber reinforced polymeric material.” *Id.*, col. 2, lines 57-60. Therefore, the coated fibers in *Raghupathi* are effectively embedded within the polymeric material in which they are incorporated, with little or no contact with any external surfaces. Such a teaching in *Raghupathi* clearly would lead one skilled in the art away from the combination of this reference with *Kotera*, where the claimed polyester resin is utilized on external surfaces.

Based on these teachings, there is nothing in either reference that would have led one of ordinary skill in the art to modify and combine the teachings of *Kotera* and *Raghupathi* to include, *inter alia*, “[a] fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible powdered coating composition on at least a portion of a surface of the fabric, . . . wherein the at least one fiber strand comprises at least one glass fiber.” Thus, there is no evidence to support any motivation for one skilled in the art to make the claimed invention. Accordingly, Applicants assert that the present rejections should be withdrawn.

3. There is no evidence of a reasonable expectation of success

In addition to showing a motivation to modify/combine the prior art references to make the claimed invention, the Examiner must show why a person of ordinary skill in the art would have had a reasonable expectation of success for such a modification/combination. See, e.g., M.P.E.P. §2143.02.

In the present case, the Examiner has not presented evidence that the teachings of *Kotera* and *Raghupathi* would have provided one of ordinary skill in the art with a

reasonable expectation of success in making the present invention. Rather, the Examiner remains silent as to how the teachings of either reference would suggest to one skilled in the art that the present invention could be claimed successfully. The Federal Circuit has recently held that the Patent Office must not only “assure that the requisite findings [of motivation] are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Thus, the Examiner’s silence in this regard implies a reliance on “common knowledge and common sense.” Such reliance, however, does not fulfill the Office’s obligation to cite references to support its conclusions. *Id.* at 1344, 61 U.S.P.Q.2d at 1434.

Applicants submit that an expectation of success is not warranted by the teachings of *Kotera* and *Raghupathi* in view of the fact that (1) neither reference teaches “[a] fabric comprising at least one strand comprising a plurality of fibers and having a resin compatible powdered coating composition on at least a portion of a surface of the fabric, . . . wherein the at least one fiber strand comprises at least one glass fiber” and (2) both references teach away from the combination of the teachings of the two references.

As a result, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness pursuant to M.P.E.P. § 2143.02, and respectfully request that the Section 103 rejection of claims 1, 4-8, 13-14 and 18-32 be withdrawn.

III. **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 26, 2004

By: 

Mark D. Sweet
Reg. No. 41,469